

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte: DANNY BOWMAN, JASON BOWMAN,  
DAVID LEWIS AND RICHARD PAISLEY

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Application No. 09/737,185

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on October 9, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

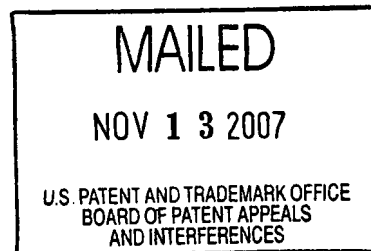
**APPEAL BRIEF**

**Summary Of Claimed Subject Matter**

Appellant filed an Appeal Brief dated September 5, 2006, in response to the Non-Final Rejection mailed January 10, 2006. The Appeal Brief is not in compliance with the 37 CFR § 41.37(c) effective September 13, 2004. 37 CFR § 41.37(c) states in part:

***(v) Summary Of Claimed Subject Matter.***

The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by **page and line number** and to the drawings, if any, by reference characters; and/or



(b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).

The “Summary of claimed subject matter” appearing on page 3 of the Appeal Brief filed September 5, 2006, is deficient because it does not map independent claims 9 and 18 to the specification.

### **Grounds of Rejection to be Reviewed on Appeal**

In the “Grounds of Rejection to be Reviewed on Appeal” section of the brief a statement of each grounds of rejection was listed however, for rejection “B” appellant included a 102(b) statute as opposed to a 102(e) statute. Grounds “H” included the “Bowman” reference in the statement of rejection however, the examiner rejected claim 3-4 and 11-12 under 35 U.S.C 103(a) as being unpatentable over Berney in view of Stevens et al..

Clarification is required.

### **EXAMINER’S ANSWER**

#### **New Grounds of Rejection**

On January 30, 2007, an Examiner’s Answer was mailed. The Examiner’s Answer included a new ground of rejection, where Claims 16-17, 20 and 42-44 were rejected under 35 U.S.C §103 (a) over Petrick or Berney in view of Hoffman et al. or Fukuzaki. A review of the applications reveals claim 44 was rejected under 35 U.S.C 102(e) as being anticipated by Petrick in the Non-Final Rejection mailed January 10, 2006.

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When a new ground of rejection is introduced in the Examiner's Answer, the Examiner is required to obtain approval of the Technology Center Director or his/her designee. Further, any new ground of rejection is required to be prominently identified, eg., a separate heading with all capitalized letters. See MPEP § 1207.02(A)(6)(d).

To correct this problem, the examiner will need to vacate the Examiner's Answer mailed January 30, 2007, and mail a Supplemental Examiner's Answer with the approval of the Technology Center Director or designee.

#### **English Translation**

The Examiner's Answer includes a rejection for claims 2, 8, 10 and 17, under 35 U.S.C. 103(a). The examiner relied upon the Anonym RD 421048 document for the rejection of the claims on appeal. No full translation of the above reference has been provided. Rather, the Examiner relies upon an abstract.

The Examiner must provide a complete translation of the RD 421048 reference relied upon in the rejection of the claims on appeal. Further, a copy of the translation should be mailed to appellant and forwarded for scanning into IFW.

#### **REPLY BRIEF**

Appellant filed a Reply Brief January 16, 2007 and February 6, 2007. On April 18, 2007 the examiner improperly acknowledged the Reply Brief and included a rebuttal to the Reply Brief. The examiner should vacate the acknowledgment of Reply Brief mailed on June 13, 2007 and re-issue a corrected acknowledgement as per 37 CFR § 41.43.

The Examiner must consider and acknowledge receipt of the Reply Brief filed January

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16, 2007, via written communication.

MPEP § 1208.03 states:

Under 37 CFR 1.193(b)(1), appellant may file a reply brief as a matter of right....

The primary examiner must then either: (A) acknowledge receipt and entry of the reply brief... or (B) reopen prosecution to respond to the reply brief.

### **CONCLUSION**

Accordingly, it is

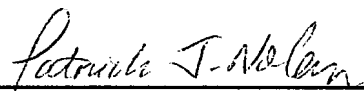
**ORDERED** that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed September 5, 2006, defective;
- 2) notify the appellant to submit a “paper” which corrects the Appeal Brief, Summary of Claimed Subject Matter under 37 § 41.37(c)(1)(v), Grounds of Rejection to be Reviewed on Appeal;
- 3) acknowledgement and consideration of any “paper” that may be submitted by Appellant in response to the Notice of Non-Compliance to correct the Appeal Brief as required by 37 § 41.37(c)(1)(v); and
- 4) issue and mail a Supplemental Examiner’s Answer that properly identifies any new grounds of rejection;

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- 5) issue a copy of the requested translation and scan into IFW;
- 6) properly consider the Reply Briefs filed January 16, 2007 and February 6, 2007; and
- 7) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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